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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/113,712	07/10/1998	EDWARD F. HELINSKI	EN997043	8352

7590

05/02/2005

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EXAMINER

PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/113,712

Applicant(s)

HELINSKI, EDWARD F.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 12-20, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 21, 22 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION**INFORMATION ON HOW TO EFFECT DRAWING CHANGES****Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

1. The drawings are objected to because the sheet disclosing amended Figure 2 does not include the label "Replacement Sheet" as shown underlined above. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency.

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Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The specification is objected to under 37 CFR 1.71, as being confusing and difficult to comprehend the invention and compare with prior art. For example, the following is not understood: It is unclear how the apertures of the upper die, the punch receiving passage of the lower die, and the punch will ever be aligned. See the rejections under 35 USC § 112, first paragraph for more details.

Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art.

Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-11, 21, 22, and 25-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way

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as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. It is unclear how the aperture of the upper die, the punch receiving passage of the lower die, and the punch will ever be aligned. It is understood that during manufacturing of the dies that the aperture may not be formed directly in the center. It is also now understood that both dies are to be rotated to align the defective holes, however, the punch is not capable of moving. The punch can only punch along the central axis, shown in Figure 2, and cannot move to re-align with the defective apertures. Assuming that the apertures are not on the central axis and that when they are rotated to alignment they are not aligned on the central axis, the punch could not perform the punching action without punching a portion of the misaligned apertures and destroying the dies because the apertures are not on the central axis. The slightest misalignment, whether it be 4.99 millionths of an inch or 1 inch, would allow for the punch not to travel through the aperture but contact the die itself. In order for the punch to perform the punching action with the upper and lower dies, the apertures must be perfectly aligned on the central axis so that the punch may travel through. In order for the apparatus to perform the punching action, the center of the punch and the center of the two apertures must be aligned on the central axis.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-11, 21, 22, and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. In regards to claims 1 and 6, it is unclear how the aperture of the upper die, the punch receiving passage of the lower die, and the punch will ever be aligned. The arguments bring up the fact that the apertures of the die are not always aligned due to a manufacturing defect, however these off centered apertures are not disclosed in the claim. The claim states "a first die including a first die aperture for receiving a punch; a second die including a second die aperture for receiving a punch" inherently discloses that the apertures and the punches are aligned. The punch cannot move and only a centered aperture is able to receive the punch, therefore, as claimed, both of the apertures are aligned. Also, the claim states "the second die passage being configured to permit at least one of the first die and the second die to rotate therein, thereby permitting the first die aperture and the second die aperture to be aligned with each other". This statement discloses that rotating the apertures leads to their alignment, however, the previously shown statement inherently discloses that the apertures are aligned to begin with. Also, the statement "permit at least one of the first die and the second die to rotate therein" discloses that only one of the dies may rotate. Therefore, if only one die rotates, the other die must inherently be aligned with the punch. If the die that rotates incorporates an aperture that is not centrally aligned, it would be impossible for the misaligned aperture to line up with the centrally located aperture because the misaligned aperture would only orbit around the central axis. In fact the only way for the

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two apertures to align would be if they have the same exact same manufacturing defect and are both rotated to the same spot. However, even if that was the case, the apertures would still be aligned off center and the punch would not be able to travel through the apertures without contacting the dies.

9. In regards to claims 5 and 10, the phrase "the first die aperture and the second die aperture are alignable to be concentric within about 5 millionths of an inch" is unclear. The term "concentric" is defined:

con·cen·tric (ken-sən'trîk) also **con·cen·tri·cal** (-trî-kel) *adjective*
Having a common center.¹

It is uncertain how the two apertures could have the same center while their centers are within 5 millionths of an inch. If the two apertures have centers that are 0.00001 millionths of an inch apart, their centers are not concentric and are not aligned.

10. It is to be noted that claims 1-11, 21, 22, and 25-28 have not been rejected over prior art. It may or may not be readable over the prior art but cannot be determined at this time in view of the issues under 35 USC § 112.

Response to Arguments

11. Applicant's arguments filed 08 February 2005 have been fully considered but they are not persuasive. See arguments disclose in the above rejections.

Conclusion

¹ The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Michon and Whister.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 571-272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

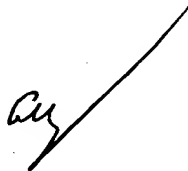
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature consisting of a stylized, looped 'J' followed by a 'P'.

JP
April 21, 2005

A handwritten signature that appears to be 'AS' followed by a long, sweeping diagonal line.

Allan N. Shoap
Supervisory Patent Examiner
Group 3700